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IN THE

Supreme Court of the United States

OCTOBER TERM, 1952.

No. 118

LANOLIN PLUS COSMETICS, INC.,
Petitioner,

vs.

JOHN A. MARZALL, COMMISSIONER OF PATENTS,

and

BOTANY MILLS, INC.,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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PETITION OF LANOLIN PLUS COSMETICS, INC. FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

TO THE HONORABLE THE CHIEF JUSTICE, AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, Lanolin Plus Cosmetics, Inc., respectfully prays for a writ of certiorari to the United States Court of Appeals for the District of Columbia Circuit to review the decision of that Court entered on April 17, 1952. A certified copy of the transcript of record including the decision in said Court is furnished herewith.

A SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

Petitioner is seeking to obtain registration of the combination of words LANOLIN PLUS as a trade mark for cosmetics and soap. Petitioner has disclaimed any right to the word lanolin alone.

Petitioner coined the expression LANOLIN PLUS as a new, unique and original combination. In order to obtain registration of its trade mark, petitioner duly filed applications under the Trade Mark Act of 1905. The Examiner of Trade Marks considered LANOLIN PLUS not to be descriptive and allowed the applications. Oppositions were then filed by respondent Botany Mills, Inc., claiming that LANOLIN PLUS should be denied registration as descriptive.

LANOLIN PLUS is a clever play on words and is designed to appeal to feminine fancy. It has attracted attention and incited sales by its unusual approach. Petitioner's LANOLIN PLUS cosmetics and soap are on sale in Washington, D.C. and throughout the country, in practically every drug and department store. Sales of LANOLIN PLUS cosmetics now exceed one million dollars annually.

For more than fifty years, the Patent Office has consistently and repeatedly held that a generic word like LANOLIN, followed by the word PLUS, is not descriptive and is registrable. There are 129 registrations of such combinations which have been granted in a consistent policy of holding such combinations non-descriptive under the Act of 1905. For example, VITAMINS PLUS, SILK PLUS, OIL PLUS and ASPIRIN PLUS have all been granted registration. Yet petitioner alone has been denied registration of an identical type of trade mark.

The Patent Office even today is following its 129 precedents and currently registering PLUS marks to others, but not to petitioner. It is absurd to say that the Patent Office made 129 successive and consistent mistakes. When PLUS marks are allowed over a hundred times for a period of fifty years, how can any one argue that this trend, this policy is an isolated error? For over fifty

years, the Patent Office has not cancelled a single PLUS registration. On the contrary, it has allowed all of them, except the LANOLIN PLUS trade mark of plaintiff.

This clearly shows unfair and arbitrary discrimination against appellant. Out of 130 applications for registration of trade marks of this kind, 129 have been allowed and only appellant has been denied registration.

Petitioner appeals to this Court as a court of equity to grant relief against the action taken by the Commissioner and the courts. It is believed that the record establishes a clear and firm basis for the granting of relief in the form of an order requiring the Commissioner of Patents to grant petitioner's trade mark the same protection under the law which has been granted to all similar trade marks, and therefore grant the registrations of LANOLIN PLUS to petitioner.

JURISDICTION.

This suit was filed in the United States District Court for the District of Columbia under Section 4915 of the Revised Statutes of the United States. (U.S.C. Title 35, Section 63)

The basis upon which it is contended that this Court has jurisdiction to review the decision of April 17, 1952, of the United States Court of Appeals for the District of Columbia Circuit is as follows: Section 18 of the Trade Mark Act of 1905, U.S.C. Title 15, Sec. 98; 28 U.S.C.A. 1254; United States Constitution, and amendments.

THE QUESTIONS PRESENTED.

1. Was the action of the Commissioner of Patents and the Courts in denying petitioner's registration of the

trade mark LANOLIN PLUS arbitrary and unfairly discriminatory in view of the granting of registration of more than 129 trade marks of the same type to others both before and after the denial of petitioner's registration?

2. Did the action of the Commissioner of Patents and the Courts constitute a clear abuse of administrative and judicial discretion?

3. Does the doctrine of equal protection of the laws under the Constitution of the United States apply to the executive and judicial branches of the federal government as well as to the states?

4. Did the denial of petitioner's registration constitute a deprival of property without due process of law and a denial of equal protection of the laws under the Constition of the United States?

5. Was the action of the Commissioner of Patents and the Courts based upon an error of law in denying petitioner's registration when the only opposing party had never used petitioner's trade mark and had no right to use or register petitioner's trade mark?

6. Was the action of the Court of Appeals for the District of Columbia arbitrary and discriminatory in view of its admission that "Appellant appears to be right in its contention that a number of similar trade marks which the Patent Office has registered are equally descriptive"?

7. Is petitioner entitled to equal justice under the law?

THE REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.

1. The Court of Appeals for the District of Columbia has not given proper effect to the applicable decision

of this Court in the case of *Beckwith* v. *Commissioner of Patents*, 252 U.S. 538.

2. The Court of Appeals for the District of Columbia has decided questions of substance relating to the construction or application of the Constitution of the United States which have not been, but should be, settled by this Court.

3. The Court of Appeals for the District of Columbia has decided a question of general and public importance relating to the registration of trade marks under the federal statutes.

4. The actions of the Commissioner of Patents and the Courts herein were arbitrary and unfairly discriminatory to petitioner and deprived petitioner of equal protection of the laws and equal justice under the law and deprived petitioner of property without due process of law, in violation of the Fifth Amendment of the Constitution.

Petitioner sets forth its argument in the brief that follows.

Wherefore it is requested that this Court grant this petition.

Respectfully submitted,

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BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

THE ACTION OF THE COMMISSIONER OF PATENTS AND THE COURTS WAS CLEARLY ARBITRARY AND DISCRIMINATORY AND SHOULD BE REVERSED.

This is a case in which the petitioner seeks registration of the trade mark LANOLIN PLUS for cosmetics and toliet preparations. Petitioner does not claim the exclusive use of lanolin alone, but only of the original and fanciful combination trade mark LANOLIN PLUS.

Ever since the Trade Mark Act of 1905 was passed, the Commissioner of Patents has allowed registrations of trade marks similar to LANOLIN PLUS. The record shows that the following trade marks have been granted registration under the Act of 1905, the same law under which petitioner seeks registration of its trade mark:

Vitamins Plus	Oil Plus
Aspirin Plus	Milk Plus
Safety Plus	Style Plus
Sweet Plus	Silk Plus
Mileage Plus	Seal Plus

Petitioner placed in evidence copies of 129 registrations of trade marks of the type substantially identical with its trade mark LANOLIN PLUS, all of which have been allowed by the Commissioner of Patents under the Act of 1905. Despite this evidence, petitioner's applications for registration of its trade mark LANOLIN PLUS were denied by the Commissioner of Patents and the Courts.

It is well established that an administrative or judicial action may be reversed by the courts where such action is shown to be arbitrary or unfairly discriminatory.

In the case of *Johnson* v. *Towsley,* 80 U.S. 68, this Court held that:

> "There has always existed in the courts of equity the power in certain classes of cases to inquire into and correct mistakes, injustice, and wrong in both judicial and executive action."

This Court held in the case of *Butterworth* v. *United States,* 112 U.S. 50, that a review of the action of the Commissioner of Patents in a case of this kind should be a trial *de novo.* This Court held with regard to Section 4915:

> "It is not a technical appeal from the Patent Office, like that created in Section 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits. Such has been the uniform and correct practice in the circuit courts."

In the case at bar, petitioner is the owner of a valuable trade mark. It sought registration of its trade mark in the Patent Office in the manner prescribed by law. The Commissioner of Patents has previously granted registration of 129 trade marks of the same type. But in this case, and in this case alone, the Commissioner of Patents denied this registration. Out of 130 applications for registration of trade marks of this kind, 129 have been allowed and only petitioner has been denied registration.

Petitioner submits that nothing could be more discriminatory, more unfair and more arbitrary than to deny petitioner the same protection under the statute that has previously been granted to other trade mark owners.

It is believed that the granting of registration of such trade marks as VITAMINS PLUS for vitamins, ASPIRIN PLUS for aspirin, MILK PLUS for milk, OIL PLUS for oil and all of the other trade marks which have been granted ever since the passage of the Trade Mark Act of 1905 constitutes a clear and firmly established

administrative policy. These registrations have been granted one after the other, year after year, and no trade mark of this kind was ever denied registration.

Yet when petitioner's applications were filed, petitioner was denied the same protection under the trade mark statute which had previously been granted to everyone else in the same position as petitioner.

Was this a change in administrative policy? It was not, because the Commissioner of Patents has allowed registrations of the same type to others on applications filed *after* those of petitioner.

The Official Gazette of the Patent Office for November 6, 1951, showed on page 24 the allowance by the Commissioner of Patents of an application for registration of the trade mark BOND-PLUS. Again, on December 25, 1951, the Commissioner of Patents allowed and published the trade mark MISTER PLUS. Both of these applications were filed and allowed **after** petitioner's applications had been filed and **after** petitioner's applications had been denied.

This is clear discrimination. It is an arbitrary and unfair distinction, drawn between petitioner on the one hand and all other trade mark owners on the other hand.

Petitioner submits that an arbitrary and unfairly discriminatory action of this kind should be reviewed and reversed by this Court. The action of the Commissioner of Patents (and the Courts in upholding him) has deprived petitioner of the same protection under the trade mark statute which had previously and subsequently been granted to everyone else.

The record further shows that petitioner has been granted registration of its trade mark LANOLIN PLUS

in every one of the 48 states of the United States and in Hawaii and Puerto Rico. Thus, the administrative agencies of every state have recognized petitioner's property right in its trade mark LANOLIN PLUS. All 48 states have granted petitioner registration of its trade mark, showing that all of them regard LANOLIN PLUS as a good, valid and registrable trade mark.

PETITIONER HAS BEEN DEPRIVED OF PROPERTY WITHOUT DUE PROCESS OF LAW.

The trade mark LANOLIN PLUS is a property right of great value to petitioner. Petitioner's entire business in the manufacture and sale of cosmetic preparations is built around the trade mark LANOLIN PLUS and the good will relating thereto. The sale of cosmetics under petitioners trade mark LANOLIN PLUS now exceeds $1,000,000.00 a year, so that petitioner's rights in this trade mark are its most substantial business asset.

In the case of *Chattanooga Foundry and Pipe Works* v. *Atlanta,* 203 U.S. 390, Mr. Justice Holmes of this Court said that:

> "A trade mark, or a trade name, or a title, is property, and is regarded as an object capable of injury in various ways."

In the case of *Beckwith* v. *Commissioner of Patents,* 252 U.S. 538, this Court held that:

> "Of course, refusal to register a mark does not prevent a former user from continuing its use, but it deprives him of the benefits of the statute, and this should not be done if it can be avoided by a fair, even liberal, construction of the Act, designed as it is to promote the domestic and foreign trade of our country."

In *Lynch* v. *United States,* 292 U.S. 571, this Court held that an Act of Congress which revoked the right

to enforce a contract by legal process was a violation of the due process clause of the Fifth Amendment. Mr. Justice Brandeis, speaking for the Court, said:

> "Contracts between individuals or corporations are impaired within the meaning of the Constitution whenever the right to enforce them by legal process is taken away or materially lessened."

In the present case, petitioner's right to enforce its trade mark rights has been materially lessened by the refusal of the Commissioner of Patents to grant registration of its trade mark. A trade mark is only as good as the protection which it receives under the law. By denying petitioner's trade mark such protection, the Commissioner of Patents has taken from petitioner a property right of substantial value.

Petitioner submits that since the action of the Commissioner of Patents has clearly been shown to be unfair, discriminatory and arbitrary, the denial of registration of petitioner's trade mark deprives petitioner of a substantial property right without due process of law, in violation of the Fifth Amendment of the Constitution of the United States. *Lynch* v. *United States,* 292 U.S. 571; *Myles Salt Co.* v. *Board of Commissioners,* 239 U.S. 478; *Johnson* v. *Towsley,* 80 U.S. 68; *Miss. R.R. Commission* v. *Mobile & Ohio R.R.,* 244 U.S. 388; *Washington* v. *Roberge,* 278 U.S. 116.

Petitioner submits that this contitutional question should be heard and decided by this Court, to protect the property rights of petitioner.

PETITIONER'S TRADE MARK IS NOT DESCRIPTIVE AND SHOULD BE GRANTED REGISTRATION UNDER THE TRADE MARK ACT OF 1905.

Petitioner submits that its trade mark LANOLIN PLUS is not "merely descriptive" of cosmetics and that

its mark should be granted registration under the Trade Mark Act of 1905.

Petitioner's trade mark consists of the fanciful combination of words LANOLIN PLUS. The only word in petitioner's trade mark which is descriptive is the word lanolin. The word PLUS certainly does not describe cosmetics or any quality or characteristic of such goods.

This Court had before it in the case of *Beckwith* v. *Commissioner of Patents,* 252 U.S. 538, the question of what should be done when only part of a trade mark is descriptive. The Court held that if a disclaimer were made of the descriptive part of the mark, the registration should be granted. The Court said that:

> "The commercial impression of a trade mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety and to strike out any considerable part of it, certainly any conspicuous part of it, would be to greatly affect its value."

The Court held that such a disclaimer would protect others in their right to use the merely descriptive part of the mark, saying that:

> "It seems obvious that no one could be deceived as to the scope of such a mark, and that the registrant would be precluded by his disclaimer from setting up in the future any exclusive right to the disclaimed part of it."

In this case, petitioner has already filed a disclaimer of the descriptive word lanolin. Since the word PLUS alone or in combination with lanolin does not describe cosmetics, there is no basis for the denial of petitioner's registration under the ruling of this Court.

The statute clearly provides that registration shall be refused only where the mark is "merely descriptive". This Court has held that registration must be granted in all other cases, including those in which only a part of the mark is descriptive and that part has been disclaimed. This Court held that "the language of the statute that no mark not within its prohibitions or provisos shall be denied registration is just as imperative as the prohibitory words of the proviso."

Petitioner submits that the action of the Commissioner of Patents and the Courts in this case is in clear conflict with the applicable decisions of this Court. It is contrary to the above ruling and also contrary to the decision of this Court in *Hamilton-Brown Shoe Co.* v. *Wolf Bros. & Co.*, 240 U. S. 251, where this Court held:

> "We do not regard the words 'The American Girl' adopted and employed by complainant in connection with shoes of its manufacture as being a geographical or descriptive term. * * * Indeed, it does not, in its primary signification, indicate shoes at all. It is a fanciful designation, arbitrarily selected by complainant's predecessors to designate shoes of their manufacture."

In the case of *Menendez* v. *Holt*, 128 U. S. 520, this Court held that the trade mark LA FAVORITA was not descriptive of flour, saying that:

> "And the fact that flour so marked has acquired an extensive sale, because the public had discovered that it might be relied on as of a uniformly meritorious quality **demonstrates that the brand deserves protection** rather than that it should be debarred therefrom, on the ground, as argued, of being indicative of quality." (Emphasis ours.)

THE RULING OF THE COMMISSIONER OF PATENTS WAS BASED ON AN ERROR OF LAW.

It is well established that an administrative or judicial action is subject to review and reversal where it is based on an error of law. *Gegiow* v. *Uhl*, 239 U. S. 3; *Ng Fung Ho* v. *White*, 259 U. S. 276.

In this case, the Commissioner of Patents and the Courts denied petitioner's registration of its trade mark LANOLIN PLUS on the basis of an opposition proceeding which was instituted by respondent Botany Mills, Inc. It is an undisputed fact that Botany Mills, Inc. has never used the trade mark LANOLIN PLUS, does not intend to use it, and does not claim the right to use or register LANOLIN PLUS.

On the basis of such a showing, the Commissioner of Patents held that Botany Mills, Inc. would be damaged by the granting of petitioner's registration. How would it be damaged? The granting of petitioner's registration would not in any way interfere with respondent's use of the word lanolin, since petitioner has disclaimed the word lanolin.

Respondent Botany Mills, Inc. admitted that it owns no trade mark rights in the word lanolin, all of its goods being sold under the trade mark BOTANY. It has admitted that no one would think of any product as respondent's unless it bore the trade mark BOTANY.

The opposition proceeding could not be sustained on the basis of respondent's prior trade mark rights in LANOLIN PLUS, since respondent admitted that it had no trade mark rights to the term LANOLIN PLUS or any part thereof.

Petitioner submits that the sustaining of the opposition on the ground that respondent Botany Mills, Inc. would be damaged by the granting of petitioner's registration was a clear error of law. Respondent Botany Mills, Inc. had no right, as a matter of law, to oppose the granting of petitioner's registration, since it had and claimed to have no prior rights or rights of any kind to petitioner's trade mark LANOLIN PLUS.

PETITIONER IS ENTITLED TO EQUAL JUSTICE UNDER THE LAW AND TO EQUAL PROTECTION OF THE LAWS.

It is a fundamental principle of American justice and of any system of justice which is not a mockery of the term that every person is entitled to equal protection of the laws and to equal justice under the law.

Above the portals of the building which houses the Supreme Court of the United States is inscribed the legend "Equal Justice Under Law".

The doctrine of equal justice and equal protection of the laws is a fundamental part of our Constitution and our system of government. It is but one manifestation of the pronouncement in the Declaration of Independence that "All men are created free and equal."

It is believed that the doctrine of equal justice and equal protection under the law is a fundamental right which is granted to everyone and which applies to the executive and judicial branches of the federal government as well as to the states.

The action of the Commissioner of Patents and the Courts in this case clearly deprived petitioner of its fundamental right to equal justice under the law. The law protects the trade mark of everyone except petitioner.

It is believed that petitioner's right to equality and justice should be upheld by this Court against the arbitrary and unfairly discriminatory actions of the Commissioner of Patents and the Courts.

Petitioner submits that its petition for writ of certiorari should be granted.

Respectfully submitted,

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